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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/
BELLSOUTH I.P. CORP
100 GALLERIA PARKWAY
SUITE 1750
ATLANTA, GA 30339

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT PAPER NUMBER

2145

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,816

Applicant(s)

MALIK, DALE W.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☒ Claim(s) 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This case has been reassigned to a new examiner.

Claim Objections

2. Claim 47 is objected to because of the following informalities: Claim 47 refers to the *message of claim 44*, when claim 44 is in fact a claim for a *method*. Based upon claims 45, 46 and 48, the Examiner believes this is a typographical mistake rather than a change of embodiment. Therefore, for purposes of compact prosecution, claim 47 is treated as *The method of claim 44*, rather than *The message of claim 44*. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5-8, 10-13, 21, 23, 25, 27-30, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Horstmann et al. (U.S. Patent No. 6,779,022).
5. In regard to claims 1, 23 and 49, Horstmann discloses *receiving an email message at the source email server, wherein said email message has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network; checking a database to determine a permission for the destination email address; and applying the instruction to the set of email messages if the permission is granted*. Horstmann discloses a method of filtering and forwarding email. A communications server receives messages through a mail interface. The user can retrieve all messages from any device that

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provides Internet access. The communications server dispatches messages to an appropriate receiving device based on the user's needs. A filter applies blocking and filtering rules to the messages, and filtered messages are dispatched to an appropriate user device. A user authentication module allows the user to verify their identity before confirming mail settings. See Horstmann, column 3, lines 22-38, lines 46-55, column 4, lines 2-18, lines 36-44, column 5, lines 1-5. The database in claim 1 is inherent to an email filtering system that uses filtering and blocking rules for messages. The database in claims 23 and 49 is inherent to a user authentication module. Claims 1, 23 and 49 are broad enough as to be read to simply encompass an email filter that is not as specific as the mail management system taught by Horstmann.

6. In regard to claim 5, Horstmann is applied as in claim 1. Horstmann also discloses filtering messages by subject field criteria. See Horstmann, Figure 6, column 7, line 61 – column 8, line 6.

7. In regard to claim 6, Horstmann is applied as in claim 1. It is inherent to any SMTP email system that the email header will include the identity of the message sender.

8. In regard to claims 7-8, Horstmann is applied as in claim 1. Claims 7-8 add the additional limitations of *the code comprises a predetermined data string, the second field comprises a message addressee field, and the predetermined data string corresponds to an email account on the source server.* These limitations essentially say that an email has information about the sender of the email, which is inherent to any email system.

9. In regard to claim 10, Horstmann is applied as in claim 1. Horstmann does not explicitly disclose a retrieve command that sends email to its destination, but such a system is inherent to the Horstmann system since Horstmann is an email management system that deals with routing email to various devices and various devices must still *retrieve* the email from Horstmann.

10. In regard to claim 11, Horstmann is applied as in claim 1. Horstmann also discloses *the instruction comprises a command and a criteria, and wherein in response to said instruction, step (c) further comprises the steps of searching a mailbox associated with the subscriber account to select the predetermined set of email messages according to the criteria.* Horstmann discloses filtering mail

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messages. This filtering can be done by sender or subject line criteria. See Horstmann, Figure 6, column 7, line 61 – column 8, line 6.

11. In regard to claim 12, Horstmann is applied as in claim 11. It is inherent to any email management system that a command must be able to be issued in order to retrieve email messages from the system.

12. In regard to claim 13, Horstmann is applied as in claim 11. It is inherent to any email management system that a command must be able to be issued in order to delete email messages from the system since no email management system has infinite storage capacity.

13. In regard to claim 21, Horstmann is applied as in claim 1. Horstmann further discloses *the third field comprises a message body field*. It is inherent to email systems that an email message will include a message body.

14. In regard to claim 25, Horstmann is applied as in claim 23. Horstmann further discloses *populating the database with a device type associated with each subscriber email address, and wherein step (c) further comprises the steps of checking the database for a device type corresponding to the destination email address, determining if the device type is compatible with the instruction, and modifying the instruction according to the device type*. Horstmann discloses compatibility with multiple message receiving devices. Horstmann, column 4, lines 2-7. The email addresses can be associated with different locations. Horstmann, column 3, lines 28-39. Email retrieval can be modified for various devices, by use of HTML, WML, and HDML formats for content. Horstmann, column 4, lines 47-65.

15. In regard to claim 27, Horstmann is applied as in claim 23. It is inherent to any email system to include a retrieve command in order to send messages from the server to the recipient on the request of the recipient.

16. In regard to claim 28, Horstmann is applied as in claim 23. The limitations embodied within claim 28 are substantially the same as the limitations within claim 11. Therefore the rejection against claim 11 is equally applicable to claim 28.

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17. In regard to claim 29, Horstmann is applied as in claim 28. The limitations embodied within claim 29 are substantially the same as the limitations within claim 12. Therefore the rejection against claim 12 is equally applicable to claim 29.

18. In regard to claim 30, Horstmann is applied as in claim 28. The limitations embodied within claim 30 are substantially the same as the limitations within claim 13. Therefore the rejection against claim 13 is equally applicable to claim 30.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 14, 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann.

21. In regard to claim 14, Horstmann is applied as in claims 11-13. It would be obvious to one of ordinary skill in the art at the time of the invention to use both a retrieve command and a delete command with an email management system in order to delete the messages from the server after they have been retrieved in order to conserve disk space on the server.

22. In regard to claim 22, Horstmann is applied as in claim 1. Horstmann discloses the ability of a mail system to filter messages according to certain criteria. See Horstmann, Figure 6, column 7, line 61 – column 8, line 6. Horstmann fails to disclose a default action by a filter if the criteria are not defined. However, such a default action is well known in the art of network filters. Furthermore, such a default action could be considered the “else” portion of an if/else section of programming or a “switch” statement in c programming which has a “default” condition, which are both simple ways of looking at a network filtering mechanism. Therefore, it would be obvious to one of ordinary skill in the networking art at the time of the invention to have a default condition for a filtering mechanism within the Horstmann invention

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to allow messages which have not had filtering rules created which match their criteria to be treated and not discarded.

23. In regard to claim 31, Horstmann is applied as in claim 28. The limitations embodied within claim 31 are substantially the same as the limitations within claim 14. Therefore the rejection against claim 14 is equally applicable to claim 31.

24. Claims 2-4, 26, 38, and 41-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann as applied to claims 1 and 23 above, and further in view of Chapman (Majordomo: How I Manage 17 Mailing Lists Without Answering "-request" Mail, 1992 LISA VI, October 19-23, 1992, Long Beach, CA).

25. In regard to claim 2, Horstmann is applied as in claim 1. Horstmann discloses an email filtering and forwarding system that works over a web client based on determining that the subscriber has authorization to alter their mail settings. Horstmann further discloses a database with user-specific information for filtering email. See Horstmann, column 6, lines 17-23, Figure 5, Figure 8. Figure 8 specifically deals with device specific information. See Horstmann, column 6, lines 54-59 for forwarding and filtering email to specific device types. Horstmann fails to disclose sending commands to alter mail settings through an email message. However, Chapman discloses the ability to parse email messages for commands to control an email server using a program developed in 1992, before the usage of html web page forms to submit information via email became well known in the networking art. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the Horstmann invention to send email filtering and forwarding commands to a server by using an email command system similar to Chapman in order to allow a machine without a graphic user interface, such as an old UNIX "dumb terminal", to manage email.

26. In regard to claim 3, Horstmann and Chapman are applied as in claim 2. Chapman fails to disclose modifying the response of the system for the device. However, Horstmann further discloses that the mail management system can be interfaced with various devices, and that the system supports Hypertext Markup Language, Wireless Markup Language, and Handheld Device Markup Language to allow message to be sent to said various devices. See Horstmann, column 4, lines 47-65. It would have

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been obvious to one of ordinary skill in the art at the time of the invention to modify the Horstmann/Chapman combination for use with various devices in order to allow someone using a common text device such as a pager, cell phone or Palm device to access and control email.

27. In regard to claim 4, Horstmann and Chapman are applied as in claim 2. Horstmann describes an email management system. Chapman describes sending commands via email. Horstmann further describes a user authentication system. The motivation to combine Horstmann and Chapman has already been given in the rejection for claim 2. Furthermore, it would be obvious to one of ordinary skill in the art that if Chapman can parse email messages for commands and Horstmann includes a user authentication system, that one could send commands to the user authentication system via email messages to be parsed.

28. In regard to claim 26, Horstmann is applied as in claim 23. The limitations within this claim are substantially the same as the limitations embodied within claim 4. Therefore the rejection against claim 4 is equally applicable against claim 26.

29. In regard to claim 38, Horstmann and Chapman are applied as in claim 26. The limitations within this claim are substantially the same as the limitations embodied within claim 26. Therefore the rejection against claim 26 is equally applicable against claim 38.

30. In regard to claim 41, Horstmann and Chapman are applied as in claim 38. Chapman has already disclosed parsing commands from email messages. Horstmann has already disclosed filtering messages based on commands. Therefore it would have been obvious to one of ordinary skill in the art to filter messages in the Horstmann system based on commands parsed from an email as taught by Chapman for the same motivation as the motivations for the rejections for claims 2-4.

31. In regard to claim 42, Horstmann and Chapman are applied as in claim 41. It is inherent to any email system that an email message contains a message body.

32. In regard to claim 43, Horstmann and Chapman are applied as in claim 38. It would be obvious to one of ordinary skill in the art to delete an email after sending it from the mail server to conserve drive space on the server.

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33. In regard to claim 44, Horstmann and Chapman are applied as in claim 26. The limitations within this claim are substantially the same as the limitations embodied within claim 26. Therefore the rejection against claim 26 is equally applicable against claim 44.

34. In regard to claim 45, Horstmann and Chapman are applied as in claim 44. It is inherent to all email systems that an email message contains a subject field.

35. In regard to claim 46, Horstmann and Chapman are applied as in claim 44. It is inherent to all email systems that an email message contains a message body.

36. In regard to claim 47, Horstmann and Chapman are applied as in claim 44. Horstmann also discloses *the instruction comprises a command and a criteria, and wherein in response to said instruction, step (c) further comprises the steps of searching a mailbox associated with the subscriber account to select the first email message according to the criteria and executing said command.*

Horstmann discloses filtering mail messages. This filtering can be done by sender or subject line criteria. See Horstmann, Figure 6, column 7, line 61 – column 8, line 6.

37. In regard to claim 48, Horstmann and Chapman are applied as in claim 44. Horstmann discloses a user authentication module as previously shown. A database with a plurality of subscriber accounts and associated email addresses would be inherent to such an authentication module.

38. Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann in view of Netscape Mail Server Administrator's Guide (Netscape Communications Corporation, 1996).

39. In regard to claims 9 and 24, Horstmann is applied as in claims 1 and 23. Horstmann discloses an email management and filtering system with a user authentication module. Horstmann fails to disclose sending a message if unable to perform a task. However, Netscape Mail Server Administrator's Guide discloses sending error messages from the mail server when it is unable to carry out a task. See Netscape Mail Server Administrator's Guide, 65-66. Netscape Mail Server is analogous art because it is the operating guide to a mail server, as is presented in Horstmann. It would be obvious to one of ordinary skill in the art at the time of the invention to have the mail server send an error message for any number of reasons, including the inability to perform a task.

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40. Claims 15-20 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann in view of cc:Mail for Windows User's Guide.

41. In regard to claim 15, Horstmann is applied as in claim 11. Horstmann fails to explicitly disclose filtering messages based upon the sender. However, cc:Mail discloses that mail programs commonly filter email messages by sender. cc:Mail is an example email program, and is analogous because it receives SMTP mail like Horstmann. See cc:Mail, 152, Table 8-1. cc:Mail uses the same conditions for filtering rules as it does in searching messages. See cc:Mail, 166. It would be obvious to one of ordinary skill in the networking art at the time of the invention to filter email based upon the sender, in order to allow the user to define which messages they choose to receive and which they choose not to receive.

42. In regard to claim 16, Horstmann is applied as in claim 11. Horstmann fails to explicitly disclose filtering messages based upon the message subject line. However, cc:Mail discloses that mail programs commonly filter email messages by the message subject line. cc:Mail is an example email program, and is analogous because it receives SMTP mail like Horstmann. See cc:Mail, 166-167, figures 9-4 and 9-5. It would be obvious to one of ordinary skill in the networking art at the time of the invention to filter email based upon the message subject line, in order to allow the user to eliminate extraneous spam messages.

43. In regard to claim 17, Horstmann is applied as in claim 11. Horstmann fails to explicitly disclose filtering messages based upon the date of the message. However, cc:Mail discloses that mail programs commonly filter email messages by date. cc:Mail is an example mail program, and is analogous because it receives SMTP mail like Horstmann. See cc:Mail, 167, figure 9-5. It would be obvious to one of ordinary skill in the networking art at the time of the invention to filter email based upon the message date in order to allow the user to control which messages the user receives and how old those messages are.

44. In regard to claim 18, Horstmann is applied as in claim 11. Horstmann fails to explicitly disclose filtering messages with a Boolean operation and a plurality of date strings. However, cc:Mail discloses that mail programs commonly filter email messages with a Boolean operation and a plurality of date strings. cc:Mail is an example mail program, and is analogous because it receives SMTP mail like Horstmann. See cc:Mail, 167, figure 9-5. It would be obvious to one of ordinary skill in the networking art

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at the time of the invention to filter email based upon the message date in order to allow a user to control which messages they receive.

45. In regard to claim 19, Horstmann is applied as in claim 11. The rejection for claim 15 deals with filtering based upon the mail sender. The rejection for claim 16 deals with filtering based upon the subject line. cc:Mail teaches that multiple filtering rules can be applied to email messages. See cc:Mail, 166-167, figures 9-4 and 9-5. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to filter email using multiple rule conditions in order to allow the user better control over the management of their email.

46. In regard to claim 20, Horstmann is applied as in claim 11. Horstmann fails to explicitly disclose filtering messages by the recipient of the message. However, cc:Mail discloses that mail programs commonly filter email messages by the recipient of the message. cc:Mail is an example mail program, and is analogous because it receives SMTP mail like Horstmann. See cc:Mail, 152, table 8-1. It would be obvious to one of ordinary skill in the networking art at the time of the invention to filter email based upon the recipient in order to allow a user to control which messages they receive.

47. In regard to claim 32, Horstmann is applied as in claim 28. The limitations within this claim are substantially the same as the limitations embodied within claim 15. Therefore the rejection against claim 15 is equally applicable against claim 32.

48. In regard to claim 33, Horstmann is applied as in claim 28. The limitations within this claim are substantially the same as the limitations embodied within claim 16. Therefore the rejection against claim 16 is equally applicable against claim 33.

49. In regard to claim 34, Horstmann is applied as in claim 28. The limitations within this claim are substantially the same as the limitations embodied within claim 17. Therefore the rejection against claim 17 is equally applicable against claim 34.

50. In regard to claim 35, Horstmann is applied as in claim 28. The limitations within this claim are substantially the same as the limitations embodied within claim 18. Therefore the rejection against claim 18 is equally applicable against claim 35.

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51. In regard to claim 36, Horstmann is applied as in claim 28. The limitations within this claim are substantially the same as the limitations embodied within claim 19. Therefore the rejection against claim 19 is equally applicable against claim 36.

52. In regard to claim 37, Horstmann is applied as in claim 28. The limitations within this claim are substantially the same as the limitations embodied within claim 20. Therefore the rejection against claim 20 is equally applicable to claim 37.

53. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann in view of Chapman in further view of cc:Mail.

54. In regard to claim 39, Horstmann and Chapman are applied as in claim 38. Horstmann and Chapman fail to explicitly disclose filtering messages based upon the message subject line. However, cc:Mail discloses that mail programs commonly filter email messages by the message subject line. cc:Mail is an example email program, and is analogous because it receives SMTP mail like Horstmann. See cc:Mail, 166-167, figures 9-4 and 9-5. It would be obvious to one of ordinary skill in the networking art at the time of the invention to filter email based upon the message subject line, in order to allow the user to eliminate extraneous spam messages.

55. In regard to claim 40, Horstmann and Chapman are applied as in claim 38. Horstmann and Chapman fail to explicitly disclose filtering messages based upon the sender [*message addressee*]. However, cc:Mail discloses that mail programs commonly filter email messages by sender. cc:Mail is an example email program, and is analogous because it receives SMTP mail like Horstmann. See cc:Mail, 152, Table 8-1. cc:Mail uses the same conditions for filtering rules as it does in searching messages. See cc:Mail, 166. It would be obvious to one of ordinary skill in the networking art at the time of the invention to filter email based upon the sender, in order to allow the user to define which messages they choose to receive and which they choose not to receive.

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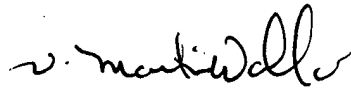
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRS


VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700